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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,460	07/29/2003	John T. Ness	H295.101.101	7324
25281	7590	01/25/2006	EXAMINER	
<b>DICKE, BILLIG &amp; CZAJA, P.L.L.C.</b> FIFTH STREET TOWERS 100 SOUTH FIFTH STREET, SUITE 2250 MINNEAPOLIS, MN 55402				HECKENBERG JR, DONALD H
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/629,460	NESS, JOHN T.
	Examiner Donald Heckenberg	Art Unit 1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 03 November 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-67 is/are pending in the application.  
 4a) Of the above claim(s) 55-67 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3,9-16,23-33,40-44 and 50-54 is/are rejected.  
 7) Claim(s) 4-8,17-22,34-39 and 45-49 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 29 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

1. Applicant's election of Group I (claims 1-54) in the reply filed on 03 November 2005 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claims because the examined application claim is either anticipated by, or would have been obvious over, the reference claims. See In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3, and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3 and 4 of copending Application No. 10/879,381 (hereinafter "App. '381").

Claims 3 and 4 of App. '381 define a mold assembly for manufacturing concrete blocks and adapted for use in a concrete block machine that includes, among other things, all of the features defined in claims 1, 3, and 9 of the instant application. As such, claims 3 and 4 of App. '381 anticipate claims 1, 3, and 9 of the instant application.

This is a provisional obviousness-type double patenting rejection.

4. Claims 10-16, 23-27, 29-33, 40-44, and 50-54 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3 and 4 of copending App. '381 in view of Ruckstuhl (U.S. Pat. No. 4,869,660; previously made of record in an I.D.S. filed by Applicant).

As noted above, claims 3 and 4 of App. '381 define a mold assembly for manufacturing concrete blocks with many of the features defined in claims 2, 23-31, and 50-54 of the instant application. These claims of App. '381 do not recite the liner plates to include a liner face that is a negative of the desired block shape, or the liner face to comprise a polyurethane or a metal alloy material. These claims of App. '381 also do not recite the mold assembly to include a mold frame with side and cross members, as well as a plurality of division plates. As described more fully below, however, Ruckstuhl discloses an apparatus for fabrication of concrete blocks, which includes such liner plates, side and cross members, as well as a plurality of division plates. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the device recited the claims of App. '381 as such to comprise such liner plates, side and cross

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members, and division plates because these structures are advantageous within the molding apparatus as suggested by Ruckstuhl (note the particular functions of these structures within the apparatus disclosed by Ruckstuhl as described below).

This is a provisional obviousness-type double patenting rejection.

5. Claims 1, 3, and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 8, and 17-20 copending Application No. 11/036,147 (hereinafter "App. '147").

Claims 1, 7, 8, and 17-20 of App. '147 define a mold assembly for manufacturing concrete blocks and adapted for use in a concrete block machine that includes, among other things, all of the features defined in claims 1, 3, and 9 of the instant application. As such, claims 1, 7, 8, and 17-20 of App. '147 anticipate claims 1, 3, and 9 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 10-16, 23-27, 29-33, 40-44, and 50-54 are provisionally rejected on the ground of nonstatutory

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obviousness-type double patenting as being unpatentable over claims 1, 7, 8, and 17-20 of copending App. '147 in view of Ruckstuhl.

As noted above, claims 1, 7, 8, and 17-20 of App. '147 define a mold assembly for manufacturing concrete blocks with many of the features defined in claims 2, 23-31, and 50-54 of the instant application. These claims of App. '147 do not recited the liner plates to include a liner face that is a negative of the desired block shape, or the liner face to comprise a polyurethane or a metal alloy material. These claims of App. '147 also do not recite the mold assembly to include a mold frame with side and cross members, as well as a plurality of division plates. As described more fully below, however, Ruckstuhl discloses an apparatus for fabrication of concrete blocks, which includes such liner plates, side and cross members, as well as a plurality of division plates. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the device recited the claims of App. '147 as such to comprise such liner plates, side and cross members, and division plates because these structures are advantageous with in the molding apparatus as suggested by Ruckstuhl (note the particular functions of

these structures within the apparatus disclosed by Ruckstuhl as described below).

This is a provisional obviousness-type double patenting rejection.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

8. Claims 1, 2, 23-31, and 50-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruckstuhl.

Ruckstuhl discloses an apparatus for fabrication of concrete blocks. The apparatus includes a plurality of liner plates (5), with each liner plate having a major surface (18). The liner plates are configured such that the major surfaces form a mold cavity having the desired form of the block to be molded (see Fig. 2).

Ruckstuhl further discloses the liner plates to be movable through the use of a gear drive assemblies (see Fig. 2). The drive assemblies (including components 8, 9, 11 and 12) are

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coupled to the plates and configured to move the liner plates in a first direction toward an interior of the mold cavity by applying a force in a second direction that is perpendicular to the first direction (Fig. 2 and cl. 3, ll. 27-55). The drive assemblies are further configured to move the liner plates in a direction away from the interior of the mold cavity by applying a force in a direction opposite the second direction (Fig. 2 and cl. 3, ll. 27-55).

As shown in Fig. 2, the apparatus of Ruckstuhl includes a frame with a pair of side members and cross members coupled together to thereby form a mold box (see Figs. 2 and 3). Division plates are provided parallel with and between the cross member to form a plurality of sub boxes, thus allowing for the formation of a plurality of molded blocks (see Fig. 2).

Ruckstuhl still further discloses that the liner faces may comprise either polyurethane or metal alloy materials (cl. 3, l. 61 - cl. 4, l. 3).

9. Claims 1, 3, and 9 are rejected under 35 U.S.C. 102(f) because the Applicant did not invent the claimed subject matter.

As described above in the double patenting rejection, App. '381 includes claims anticipating all of the features recited in claims 1, 3, and 9. Although, App. '381 share one common

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inventor with the instant application, App. '381 includes an additional inventor, and thus has a different inventive entity. See MPEP 2137.01. There has not as of yet been any showing that the invention of App. '381 and that of the instant application were commonly owned at the time Applicant's invention. As such, there is a *prima facie* case that Applicant is not the only inventor of the subject matter of the instant application.

10. Claims 4-8, 17-22, 34-39, and 45-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following references cited but not relied upon are deemed pertinent to the instant application:

Sterling (U.S. Pat. No. 779,976) discloses a molding machine.

Hole (U.S. Pat. No. 1,993,930) discloses a mold for building constructional elements of concrete.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald

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Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

  
Donald Heckenberg  
Primary Examiner  
A.U. 1722

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